**MAIL STOP AF**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In Re: Patent Application of Michael Plotnick et al:**

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| Conf. No.: 5480 | : | Group Art Unit: 2621 |
| Appln. No.: 10/006,874 | : | Examiner: Huy Thanh Nguyen |
| Filing Date: 14 NOVEMBER 2001 | : | Attorney Docket No.: T738-10 |

Title: Alternative Advertising in Pre-recorded Media

**Request for Pre-Appeal Brief Conference**

Applicant(s) request(s) review of the final rejection in the above-identified application, under the Pre-Appeal Brief Conference Program published on July 12, 2005. No amendments are being filed with this request.

☒ The review is requested for the reason(s) stated on the attached sheet(s).

☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is filed herewith.

Date: 12/17/07

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**STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE**

Presently, claims 1-27, 29-34, 36-54, 57-59, 63-68, 100-113, and 118-121 are pending in the application. Claims 70-98 have been withdrawn in compliance with a restriction requirement. This paper is being filed in support of the Request for Pre-Appeal Brief Conference submitted herewith. Details of the Examiner's rejections may be found in the Final Office Action dated September 25, 2007 ("Final Office Action") and the Examiner's Non-Final Office Action dated February 26, 2007 ("Non-Final Office Action"). Discussion of the prior art references and the pending claims may be found in Applicants' Request for Reconsideration filed June 11, 2007 ("Request for Reconsideration").

Even though the Examiner has not established a *prima facie* case for obviousness, the Examiner has not withdrawn the rejection of claims 1-2, 20-27, 29-34, 36-56, 59-68, 100-113, and 118-121 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,909,837 to Unger *et al.* ("Unger") in view of U.S. Patent No. 6,006,257 to Slezak *et al.* ("Slezak"). The Examiner contends that Unger discloses a method for displaying an alternative advertisement during a trick-play event, but acknowledges that Unger does not teach or suggest "a control means for ignoring the termination of trick play event mode during the recorded advertisement portion being viewed." The Examiner further contends that Slezak teaches the features that Unger lacks, and concludes that it would have been obvious to combine the teachings of Slezak with Unger. Applicants respectfully traverse this rejection.

The Examiner contends that the proposed combination results in "Unger with a control means as taught by Slezak for detecting an end of a trick play event and continuing the trick play of the recorded advertisement until the end of the recorded advertisement thereby enhancing the capacity of the apparatus of Unger in order to force a viewer to view a certain portion of the program." (See Final Office Action, page 3). However, independent claim 1 does not recite displaying a "program", but instead recites displaying "the alternative advertisement." Therefore, even if the combination teaches what the Examiner argues, the combination still fails to teach all aspects of claim 1.

Furthermore, Applicants disagree that the combination of Unger and Slezak would yield the result stated by the Examiner. The combination of Unger and Slezak does not teach or

suggest "continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement," as recited in independent claim 1. In Unger the advertisers desire the user to view the entire advertisement and not trick play through the ad. Although the advertiser in Unger desires to present the entire commercial message to the viewer, the advertiser is willing to settle for the viewer receiving an abbreviated commercial message (see Unger, column 6, lines 47-53). In Unger, if the viewer stops the trick play, the viewer is returned to normal play of the underlying ad (see Unger, column 5, lines 48-50). Since the advertiser desires that the user view the underlying advertisement in its entirety, continuing to trick play the alternative advertisement after the user indicates that he desires to resume regular playback during an advertisement is counter-intuitive and non-obvious to the teachings of Unger, and contrary to what is recited in claim 1.

Similar to Unger, Slezak's system endeavors to have the user watch an entire commercial message. The point of Slezak's invention is getting a view to view an entire advertisement without skipping or fast forwarding. For example, Slezak states:

> If the viewer is viewing a "must view" video, the process proceeds to step 2022 where it is determined whether the command requests a forward shift in the current video stream or an entirely new video stream. If command does request a forward shift or change from the current video stream, the process is waited until the current "must view" video stream is completed in step 2024. (Slezak, column 9, lines 50-56)

Therefore, Slezak does not support the notion of continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement." Slezak instead endeavors to prevent fast-forward operations. Ultimately, neither Unger nor Slezak address the desirability of continuing to trick play the recorded advertisement.

In the above quoted section, when Slezak teaches that the "process is waited," it is not a trick play process that is being "waited." Slezak instead detects an initiation of a fast forward command or a channel change, not "an end of the trick play event." Therefore, Slezak cannot be said to teach "detecting an end of the trick play event prior to the end of the recorded advertisement;" and "continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement;" as recited in claim 1.

Additionally, Slezak teaches waiting for the "must view" video to play. In Slezak, the video that the user is viewing is completed, whereas, in claim 1, it is the video that the user is not viewing (i.e. the trick playing recorded advertisement) that affects the acknowledgement of trick play commands. In other words, Slezak waits until the end of the "must view" video. In contrast, claim 1, continues "until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement..."

Furthermore, Slezak does not teach "displaying the alternative advertisement" while continuing to trick play. Instead, Slezak teaches that "the process is waited until the current "must view" video stream is completed..." This is not for a trick play event, nor is it in response to the ending of a trick play event. Further, this is not an alternative video (derived from the underlying recorded advertisement) that is being played, but instead the "must view" video that is part of the original presentation stream.

Although the Examiner states that Unger only "fails to teach a control means for ignoring the termination of trick play event mode during the recorded advertisement portion being viewed," Unger also fails to teach continuing to display the alternative advertisement as recited in claim 1. Therefore, the combination of Unger and Slezak fails to teach all aspects of independent claim 1.

Independent claim 33 recites "displaying the alternative advertisement to the subscriber, wherein said displaying includes displaying the alternative advertisement if a determination is made that the alternative advertisement can be displayed within a time period needed to trick play through the remaining portion of the recorded advertisement." However, in the Final Rejection, the Examiner does not even attempt to address whether making a determination if "the alternative advertisement can be displayed within a time period needed to trick play through the remaining portion of the recorded advertisement." Specifically, the Examiner did not attempt to address all aspects of claim 33 (Applicants have previously informed the Examiner of the deficiency, see Request for Reconsideration, page 5).

Moreover, Applicants respectfully submit that there is nothing in the prior art of record that teaches making a determination if "the alternative advertisement can be displayed within a time period needed to trick play through the remaining portion of the recorded advertisement," as

recited in independent claim 33. Neither Unger, Slezak, nor the combination thereof teach or suggest determining the time period needed to trick play through the recorded advertisement and whether the alternative advertisement can be displayed during that period. Therefore, independent claim 33 is patentable over the proposed combination of Unger and Slezak.

Independent claim 36 recites, "pausing the trick play event until said displaying alternative advertisement is complete if additional time is required to display entire alternative advertisement based on the point in advertisement that the trick play event occurs." Independent claim 63 recites, "means for automatically controlling the fast forward event, wherein if said means for detecting detects the end of the fast forward event prior to end of the recorded advertisement, said means for automatically controlling will continue to fast forward the recorded advertisement until the end of the recorded advertisement, and said means for displaying will continue to display the alternative advertisement until the end of the recorded advertisement." For similar reasons as discussed in relation to claim 1, independent claims 36 and 63 are patentable over the combination of Unger and Slezak.

Additionally, many of the dependent claims were not properly addressed by the Examiner and are provide additional patentable distinctions over the combination of Unger and Slezak. For example, dependent claims 42, 43, 53, and 113 contain additional aspects that are clearly distinct from the combination. Dependent claims 42 and 113 recite that "the processing rules are specific to the recorded advertisement." The processing rules provided by Unger are not specific to the recorded advertisement. Instead they are generic rules, simply instructing the system to display tagged I-frames (see Unger column 5, lines 39-66). Furthermore, the Examiner groups his rejection of claim 43 with claims 42 and 113, which is illogical. In contrast to claims 42 and 113 which recite that the rules are specific to the ad, claim 43 recites that "the processing rules are specific to the subscriber." The combination of Unger and Slezak do not provide subscriber specific processing rules, nor does the Examiner address this aspect of the claims.

Dependent claim 53 recites that "the alternative advertisement is not related to the recorded advertisement." In Unger, the displayed I-frames are more than just related to the recorded advertisement - they are part of the recorded advertisement. Therefore, Unger cannot be said to teach that "the alternative advertisement is not related to the recorded advertisement."

Claims 2, 20-27, 29-32, 34, 37-54, 59, and 64-68 are allowable at least by their dependence on claims 1, 33, 36, and 63, respectively. The Examiner has again rejected 55-56, and 60-62, even though these claims have been previously cancelled. Therefore their rejection is moot. Therefore it is clear that the Examiner's rejection of claims 1-2, 20-27, 29-34, 36-56, 59-68, 100-113, and 118-121 is improper and should be withdrawn.

The Examiner has rejected claims 3, 4, 7-14, 17-19 and 57-58 under 35 USC § 103(a) as being unpatentable over Unger in view of Slezak and in further view of U.S. Patent No. 4,845,564 to Hakamada et al. ("Hakamada"). Hakamada does not teach any of the aspects of claims 1 and 63 that the combination of Unger and Slezak fails to teach. Accordingly, independent claim 1 is allowable over the combination of Unger, Slezak, and Hakamada. Dependent claims 3, 4, 7-14, 17-19, and 57-58 are allowable at least due to their dependence on claim 1 and 63, respectively. Therefore it is clear that the Examiner's rejection of claims 3, 4, 7-14, 17-19 and 57-58 is improper and should be withdrawn.

The Examiner has rejected claims 5, 6, 15 and 16 under 35 USC § 103(a) as being unpatentable over Unger in view of Slezak, in further view of Hakamada, and further in view of U.S. Patent 5,031,044 to Canfield et al. ("Canfield"). Applicants believe that Canfield does not teach any of the aspects of claim 1 that the combination of Unger, Slezak, and Hakamada fails to teach. Accordingly, claim 1 is allowable over the combination of Unger, Slezak, Hakamada, and Canfield. Dependent claims 5, 6, 15, and 16 are allowable at least due to their dependence on claim 1. Therefore, it is clear that the Examiner's rejection of claims 5, 6, 15, and 16 is improper and should be withdrawn.

Applicant respectfully submits that the Examiner's rejections have been previously overcome, and that the application, including claims 1-2, 20-27, 29-34, 36-56, 59-68, 100-113, and 118-121, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and a Notice of Allowance are respectfully requested.